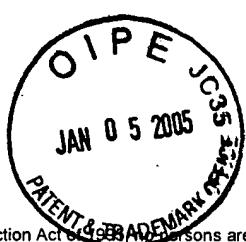


Under the Paperwork Reduction Act of 1995, persons are required to respond to a collection of information unless it displays a valid OMB control number.



FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$500.00)

Complete if Known

Application Number	09/455,534
Filing Date	December 7, 1999
First Named Inventor	MICHAEL ZIRNGIBL
Examiner Name	M. Chow
Art Unit	2645
Attorney Docket No.	067220-0313100

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None
 Deposit Account:

Deposit Account Number 033975
 Deposit Account Name PILLSBURY WINTHROP LLP

The Director is authorized to: (check all that apply)

 Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) or any underpayment of fee(s)
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	500*	2402	250*	Filing brief in support of an appeal	500.00
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 500.00)

**or number previously paid, if greater; For Reissues, see above

SUBMITTED BY

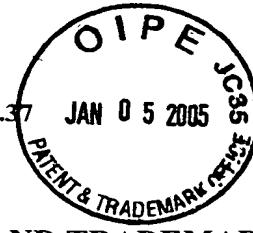
(Complete if applicable)

Name (Print/Type)	Bradford C. Blaise	Registration No. (Attorney/Agent)	47429	Telephone	703.905.2141
Signature				Date	January 5, 2005

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/455,534
Attorney Docket No. 067220-0313100



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT Michael ZIRNGIBL *et al.*
APPLICATION OF:
SERIAL NO.: 09/455,534
FILING DATE: December 7, 1999
ART UNIT : 2645
EXAMINER M. CHOW
FOR: SYSTEM AND METHOD FOR THE CREATION AND AUTOMATIC DEPLOYMENT
OF PERSONALIZED, DYNAMIC AND INTERACTIVE VOICE SERVICES, WITH
INTEGRATED INBOUND AND OUTBOUND VOICE SERVICES

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on November 5, 2004, Appellants respectfully submit Appellants' Brief on Appeal pursuant to 37 C.F.R. §41.37.

The Director is authorized to charge the \$500.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. §41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 067220-0313100).

01/06/2005 JBALINAN 00000097 033975 09455534
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REQUIREMENTS OF 37 C.F.R. §41.37

I. REAL PARTY IN INTEREST - 37 C.F.R. §41.37(c)(1)(i)

By virtue of the Assignment recorded December 7, 1999 at reel 010439, frame 0571, the real party in interest is Microstrategy, Incorporated.

II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii)

The above-referenced application claims priority to U.S. Provisional Application Serial No. 60/153,222, filed 13-Sep-1999, entitled "SYSTEM AND METHOD FOR THE CREATION AND AUTOMATIC DEPLOYMENT OF PERSONALIZED, DYNAMIC AND INTERACTIVE VOICE SERVICES."

Appellants have filed a Notice of Appeal in the two cases identified below, each of which also claim priority to U.S. Provisional Application Serial No. 60/153,222, filed 13-Sep-1999:

(1) U.S. Application Serial No. 10/430,265, filed 07-May-2003, entitled "SYSTEM AND METHOD FOR THE CREATION AND AUTOMATIC DEPLOYMENT OF PERSONALIZED, DYNAMIC AND INTERACTIVE VOICE SERVICES WITH REAL-TIME DRILLING VIA TELEPHONE." A Notice of Appeal was filed in this Application on November 23, 2004.

(2) U.S. Application Serial No. 09/661,189, filed 13-Sep-2000, entitled "SYSTEM AND METHOD FOR VOICE-ENABLED INPUT FOR USE IN THE CREATION AND AUTOMATIC DEPLOYMENT OF PERSONALIZED, DYNAMIC,

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AND INTERACTIVE VOICE SERVICES." A Notice of Appeal was filed in this Application on August 4, 2004.

III. STATUS OF CLAIMS - 37 C.F.R. §41.37(c)(1)(iii)

Pending: Claims 1-18, and 23 are pending.

Cancelled: Claims 19-22 are cancelled.

Rejected: Claims 1-18, and 23 stand rejected.

Allowed: No claims have been allowed.

On Appeal: Claims 1-18, and 23 are appealed.

IV. STATUS OF AMENDMENTS - 37 C.F.R. §41.37(c)(1)(iv)

No amendments have been filed subsequent to the mailing of the Final Office Action on May 7, 2004 (hereinafter "Final Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 C.F.R. §41.37(c)(1)(v)

In one implementation, Appellants' invention comprises an integrated inbound and outbound voice service system and method. *See Specification, e.g., pg. 9, lines 13-20; pg. 13, lines 10-12; FIGS. 3A-3C, 4, 6A-6C; and 8.*

According to an embodiment of the invention, a first system is provided for generating markup documents personalized for subscribers of at least one voice service. In an exemplary embodiment, the first system may comprise Voice Service Server (VSS) (16). *See Specification, e.g., pg. 31, lines 9-12; pg. 32, lines 3-5; pg. 34, lines 7-9; and FIGS. 3A-3B.* VSS (16) may comprise a backend server (163) which may comprise a report formatter (1631), personalization engine (1632), scheduler (1633), and SQL engine

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(1634). In one embodiment, report formatter (1631) includes an XML-based markup language engine to assemble the voice services. In a particular embodiment, report formatter (1631) includes a Telecaster Markup Language engine offered by Microstrategy Inc. to assemble the call content and structure for a call server (18). *See Specification, e.g., pg. 37, lines 1-16; and FIG. 3B.* *See also Specification, e.g., pg. 6, lines 3-13; pg. 24, line 21 – pg. 25, line 5; pg. 25, lines 8-15; pg. 28, lines 5-8; pg. 28, line 18 – pg. 29, line 4; and FIGS. 3C, 4, and 8.*

According to an embodiment of the invention, the integrated inbound and outbound voice service system further comprises a call server (18a) (*see FIG. 8*). In addition to the modules depicted in call server (18) of FIGS. 3A & 3C, call server (18a) comprises a call receiver module (1817), security module (1818), search module (1819), and an enhanced call database (1811a). *See Specification, e.g., pg. 11, line 20 – pg. 12, line 3.*

According to an embodiment of the invention, call server (18a) comprises a storage device for storing markup documents. The storage device may comprise enhanced call database (1811a). In addition to its facilities to queue and log calls, enhanced call database (1811a) includes facilities to catalog active voice pages. According to one embodiment, enhanced call database (1811a) comprises a relational or other type of database. According to this embodiment, enhanced call database (1811a) is used to store and categorize active voice pages and corresponding parameters, such as expiration dates for active voice pages. *See Specification, e.g., pg. 13, lines 3-9; and FIG. 8.*

According to an embodiment of the invention, call server (18a) further comprises a call builder (1813) (*see FIGS. 3C and 8*) operative to initiate an outbound voice-enabled communication to one or more subscribers using one or more of the markup documents,

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and a call receiver module (1817) (*see* FIG. 8) operative to accept an inbound voice-enabled communication from one or more subscribers. Call builder (1813) is the module that initiates and conducts a telephone call to a user. More particularly, call builder (1813) may dial and establish a connection with a user and pass user input through to markup language parsing engine (1812). In one embodiment, call builder (1813) comprises “Call Builder” software available from Call Technologies Inc. Call builder (1813) may be used for device detection, line monitoring for user input, call session management, potential transfer of call to another line, termination of a call, and other functions. *See* Specification, *e.g.*, pg. 39, lines 3-9; and FIGS. 3C and 8. Call receiver module (1817) enables call server (18a) to receive calls and routes the incoming calls to a security module (1818) for authentication. *See* Specification, *e.g.*, pg. 12, lines 4-11; and FIG. 8.

According to an embodiment of the invention, call server (18a) accesses one or more markup documents for dynamically interacting with one or more subscribers of a voice service during either outbound (*see* Specification, *e.g.*, pg. 6, line 14–pg. 7, line 19; pg. 30, lines 1-12; and FIG. 8) or inbound (*see* Specification, *e.g.*, pg. 10, line 1–pg. 11, line 19; pg. 12, line 11–pg. 13, line 9; and FIGS. 7-8) voice-enabled communications.

In one implementation, Appellants’ invention comprises a method for providing integrated inbound and outbound voice services to one or more users. According to an embodiment of the invention, a user may subscribe to at least one voice service that can output information. *See* Specification, *e.g.*, pg. 2, lines 14-15; pg. 14, lines 12-20; pg. 32, lines 11-12; and FIGS. 1A and 3A.

Subscribing may comprise enabling a user to specify preferences for the content and presentation of the voice service output information. *See* Specification, *e.g.*, pg. 4, lines 7-9; pg. 35, line 20–pg. 36, line 3; and FIG. 3B. Subscribing may further comprise

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enabling the user to specify a scheduling condition for executing the at least one voice service to generate the voice service output information. *See Specification, e.g., pg. 5, lines 8-13; pg. 15, lines 1-12; pg. 35, lines 3-10; and FIG. 3B.*

According to an embodiment of the invention, an outbound voice-enabled communication to the user may be initialized when the scheduling condition has been satisfied. *See Specification, e.g., pg. 5, line 14-pg. 6, line 15; pg. 15, lines 13-17; pg. 30, lines 1-4; and FIG. 1C.*

According to an embodiment of the invention, when the outbound voice-enabled communication has been successfully initialized, dynamic interaction with the user may be achieved by presenting the user with personalized voice service output information from a personalized markup language document generated for the user. *See Specification, e.g., pg. 6, lines 3-7; pg. 7, lines 1-4; pg. 30, lines 1-12; pg. 39, lines 10-14; pg. 40, lines 3-13; and FIGS. 1C and 3C.*

According to an embodiment of the invention, the personalized markup document further comprises one or more embedded user prompts for enabling the user to respond to the personalized voice service output information received. *See Specification, e.g., pg. 19, line 8 – pg. 20, line 10; pg. 42, lines 8-15; and pg. 43, lines 14-20.*

According to an embodiment of the invention, when the outbound voice-enabled communication to the user has not been successfully initialized, the personalized markup language document may be stored for subsequent retrieval and presentation to the user upon receiving an inbound voice-enabled communication from the user. *See Specification, e.g., pg. 3, lines 11-15; pg. 9, lines 17-18; pg. 10, line 16 – pg. 11, line 14; and FIG. 7.*

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL - 37 C.F.R. §41.37(c)(1)(vi)

Claims 1-4, 8-13, and 17-18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,915,001 to Uppaluru in view of U.S. Patent No. 6,385,191 to Coffman *et al.* ("Coffman"). *See* Final Action, pg. 2, ¶1.

Claims 7 and 16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 6,269,336 to Ladd *et al.* ("Ladd"). *See* Final Action, pg. 4, ¶2.

Claims 5, 6, 14, and 15 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 5,996,006 to Speicher. *See* Final Action, pg. 4, ¶3.

Claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 6,594,682 to Peterson *et al.* ("Peterson"). *See* Final Action, pg. 5, ¶4.

VII. ARGUMENTS - 37 C.F.R. §41.37(c)(1)(vii)

The rejection of each of claims 1-18, and 23 should be reversed for *at least* the reason that the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a).

Three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). The requirements are: (1) the prior art must teach or suggest all the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art, to modify the references or combine reference teachings; and (3) there must be a reasonable expectation of success. MPEP § 2143.

A. Independent claims 1 and 10.

Independent claims 1 and 10 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,915,001 to Uppaluru in view of U.S. Patent No. 6,385,191 to Coffman *et al.* (“Coffman”). Independent claims 1 and 10 are patentable for *at least* the reasons that: (1) there is no legally proper teaching, suggestion, or motivation to modify Uppaluru to include the teachings of Coffman; and (2) assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Uppaluru and Coffman, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

1. **There is no legally proper teaching, suggestion, or motivation to modify Uppaluru to include the teachings of Coffman.**

Independent claim 1 recites, *inter alia*, the features of:

a call builder *operative to initiate an outbound voice-enabled communication to one or more subscribers* using one or more of the markup documents;

.....

wherein the call server accesses one or more of the markup documents for *dynamically interacting with one or more subscribers of the at least one voice service during either outbound or inbound voice-enabled communications.*

Emphasis added.

Independent claim 10 recites, *inter alia*, the features of:

initializing outbound voice-enabled communications to one or more subscribers using one or more of the markup documents;

.....

accessing one or more of the markup documents for *dynamically interacting with one or more subscribers of the at least one voice*

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service during either outbound or inbound voice-enabled communications.

Emphasis added.

In the Final Action, the Examiner appears to concede that Uppaluru fails to disclose the feature of initiating (or initializing) an outbound voice-enabled communication to one or more subscribers, although the Examiner's rejection is somewhat confusing.

First, the Examiner recites (at pg. 2, ¶1), that Uppaluru fails to teach the feature of a call builder operative to initiate an outbound voice-enabled communication to one or more subscribers using one or more of the markup documents. The Examiner relies on Coffman, at col. 3, line 20 – col. 4, line 52, for this feature. In the next paragraph of the Final Action, however, the Examiner alleges that the voice web gateway of Uppaluru (at col. 6, lines 26-27) reads on the claimed "outbound communication to one or more subscribers."

Despite this perceived inconsistency, the two motivational statements provided by the Examiner for modifying Uppaluru to include the teachings of Coffman appear to acknowledge Uppaluru's failure to teach initiating (or initializing) an outbound voice-enabled communication. In the Final Action at pg. 3, the Examiner recites:

It would have been obvious to one skilled at the time the invention was made to modify Uppaluru to have the "a call builder.....documents" as taught by Coffman et al such that the modified system of Uppaluru would be able to support the call builder for initiating an outbound call to the system users.

The Examiner further recites, at pg. 7 of the Final Action:

It is a perfect motivation to modify the web server as taught by Uppaluru in view of Coffman et al so that the modified system of

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Uppaluru not only receives incoming calls but also initiates outbound calls.

Appellants disagree. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

However, in the passages cited above, the Examiner *appears* merely to be stating that it would be obvious to modify Uppaluru to include the feature of initiating outbound calls (as allegedly taught by Coffman), so that Uppaluru would include the feature of initiating outbound calls. This is legally improper. The Examiner's recited motivation states what the result of the combination of references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Uppaluru or Coffman themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify Uppaluru to include the teachings of Coffman. For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of independent claims 1 and 10 is improper and should be withdrawn.

2. Uppaluru and Coffman, even when combined, fail to disclose, teach, or suggest all of the elements of claims 1 and 10.

Assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Uppaluru and Coffman, the references, even if combined, fail to disclose, teach, or suggest all of the elements of claims 1 and 10. To establish *prima facie*

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obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

In the Final Action (at pg. 2, ¶1), the Examiner alleges that Coffman teaches initiating (or initializing) an outbound voice-enabled communication to one or more subscribers at col. 3, line 20 – col. 4, line 52. Appellants disagree. The passages of Coffman relied upon by the Examiner do not appear to disclose initiating (or initializing) an outbound voice-enabled communication to one or more subscribers using one or more markup documents. By contrast, Coffman appears to disclose converting a user's Internet call to a telephone call and connecting the telephone call to a call center as an inbound call. *See Coffman, e.g., col. 2, lines 5-12.*

In particular, Coffman teaches that a user of a client (100) can access a web home page (114) over Internet (102) in a conventional manner. Home page (114) has a conventional hypertext markup language (HTML) capability--such as a "call" virtual button (115)--by means of which a user can indicate a desire to speak to an agent of call center (106). When the user selects the "call" virtual button (115), a "call" activation indication is sent to Web server (103). Server (103) receives the indication, and responds by returning an "applet" (117) to browser (101) of client (100). *See Coffman, e.g., col. 3, lines 20-41; and FIGS. 1-2.* Client (100) executes the applet (117) to obtain the user's telephone number from the user, to establish an Internet connection between the Internet phone (99) and the gateway (104), and to provide the user's and call center's telephone numbers to the gateway (104). The gateway (104) uses the phone numbers to establish a

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call to the call center (106) through the telephone network (105). *See Coffman, e.g., col. 3, line 45 – col. 4, line 52; and FIGS. 1-2.*

Accordingly, the passages of Coffman (relied upon by the Examiner) teach that a user desiring to speak with an agent at a call center initiates a communication by selecting a virtual "call" button on a web page. A user's Internet call is then converted to a telephone call, and connected to a call center as an inbound call via a telephone gateway. Coffman does not teach initiating (or initializing) an outbound voice-enabled communication to one or more subscribers using one or more markup documents, as disclosed and claimed by Appellants.

Independent claims 1 and 10 are allowable over the combination of Uppaluru and Coffman for *at least* the reason that the addition of Coffman does not cure the deficiencies of Uppaluru. Accordingly, the rejection of claims 1 and 10 is improper and should be withdrawn. Appellants further submit that dependent claims 2-9 and 11-18 are allowable because they depend from allowable independent claims 1 and 10, respectively, as well as for the further limitations they contain. As such, the rejection of each of claims 1-18 should be overturned and the case passed to issue.

B. Dependent claims 4-7, 9, 13-16, & 18.

Appellants submit that dependent claims 4-7, 9, 13-16, and 18 are allowable because they depend from allowable independent claims 1 and 10, as well as for the further limitations they contain, as described below.

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1. Claims 4 and 13.

Claim 4 further recites the claim element of “*wherein the call server further comprises a search module operative to search markup documents stored in the storage device.*” Claim 13 further recites the claim element of “*searching the markup documents stored in the storage device for inbound voice-enabled communications.*” The passage relied upon by the Examiner in Uppaluru (for claims 4 and 13) does not appear to disclose these features. For example, a voice web browser (*see* Uppaluru at col. 6, lines 31-34) retrieving requested voice web pages from a voice web site does not read on a search module, as known and understood by those having skill in the art. For at least this reason, the rejection of claims 4 and 13 is improper and should be withdrawn.

2. Claims 9 and 18.

Claims 9 and 18 further recite the claim element of “*wherein the markup documents comprise information accessed from an on-line analytical processing system.*” In the Final Action, at pg. 4, the Examiner alleges that Uppaluru teaches this claim element at FIG. 2A (items 202 and 203) and col. 10, lines 19-49. Appellants disagree. The Examiner’s interpretation of a service database and service forms and pages as an on-line analytical processing (OLAP) system is incorrect and inconsistent with the separate meaning afforded to the term OLAP by those having skill in the art. For at least this reason, the rejection of claims 9 and 18 is improper and should be withdrawn.

3. Claims 7 and 16.

Dependent claims 7 and 16 are patentable under 35 U.S.C. §103(a) over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 6,269,336 to Ladd *et al.* ("Ladd").

Claims 7 and 16 further recite the claim element of "*wherein the markup documents comprise extensible markup language (XML) documents.*" In the Final Action (at pg. 4, ¶2), the Examiner concedes that the Uppaluru/Coffman combination fails to teach this claim element. The Examiner relies on Ladd, however, for the teaching of an XML document, alleging:

It would have been obvious to one skilled at the time the invention was made to modify Uppaluru and Coffman et al to have "the markup documents comprise extensible markup language (XML) documents" as taught by Ladd et al such that the modified system of Uppaluru and Coffman et al. would be able to support the XML documents to the system users.

Appellants disagree. The combination of Uppaluru and Coffman is flawed for the reasons set forth in detail above with regard to the discussion of independent claims 1 and 10. The Examiner is now further modifying this flawed combination with a third reference, Ladd, without establishing a legally proper motivation for combining the three references. The Examiner's recited motivation states what the result of the combination of the three references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Uppaluru, Coffman, or Ladd themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify the Uppaluru/Coffman combination to include the teachings of Ladd. In other words, the Examiner *appears* merely to be stating that it would be obvious to modify the

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Uppaluru/Coffman combination to include the feature of having the markup documents comprise extensible markup language (XML) documents (as allegedly taught by Ladd), so that the Uppaluru/Coffman combination would be able to support XML documents. This is legally improper. For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 7 and 16 is improper and should be withdrawn.

4. Claims 5 and 14.

Dependent claims 5 and 14 are patentable under 35 U.S.C. §103(a) over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 5,996,006 to Speicher.

Claim 5 further recites the claim element of “*wherein the search module comprises an SQL engine operative to query the storage device.*” Claim 14 further recites the claim element of “*wherein the step of searching comprises generating SQL statements to search for particular markup documents.*” In the Final Action (at pg. 4, ¶3), the Examiner concedes that the Uppaluru/Coffman combination fails to teach this claim element. The Examiner relies on Speicher, however, for this teaching, alleging:

It would have been obvious to one skilled at the time the invention was made to modify Uppaluru and Coffman et al to include a search module which comprises an SQL engine as taught by Speicher such that the modified system of Uppaluru and Coffman et al would be able to support the SQL engine to the system users.

Appellants disagree. The combination of Uppaluru and Coffman is flawed for the reasons set forth in detail above with regard to the discussion of independent claims 1 and 10. In addition, the Examiner’s rejection of claims 4 and 13 (from which claims 5 and 14

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respectively depend) is also flawed for the reasons set forth in detail above. The Examiner is now further modifying this flawed combination with a third reference, Speicher, without establishing a legally proper motivation for combining the three references. The Examiner's recited motivation states what the result of the combination of the three references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Uppaluru, Coffman, or Speicher themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify the Uppaluru/Coffman combination to include the teachings of Speicher. In other words, the Examiner *appears* merely to be stating that it would be obvious to modify the Uppaluru/Coffman combination to include the feature of the search module comprising an SQL engine (as allegedly taught by Speicher), so that the Uppaluru/Coffman combination would be able to support an SQL engine. This is legally improper. For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 5 and 14 is improper and should be withdrawn.

5. **Claims 6 and 15.**

Dependent claims 6 and 15 are patentable under 35 U.S.C. §103(a) over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 5,996,006 to Speicher.

Claim 6 further recites the claim element of “*wherein the storage device comprises a relational database.*” Claim 15 further recites the claim element of “*wherein the step of storing comprises storing markup documents in a relational database.*” In the Final Action (at pg. 5), the Examiner concedes that the Uppaluru/Coffman combination fails to

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teach this claim element. The Examiner relies on Speicher, however, for this teaching, alleging:

It would have been obvious to one skilled at the time the invention was made to modify Uppaluru and Coffman et al to include the storage device comprising a relational database as taught by Speicher such that the modified system of Uppaluru and Coffman et al would be able to support the relational database to the system users.

Appellants disagree. The combination of Uppaluru and Coffman is flawed for the reasons set forth in detail above with regard to the discussion of independent claims 1 and 10. The Examiner is now further modifying this flawed combination with a third reference, Speicher, without establishing a legally proper motivation for combining the three references. The Examiner's recited motivation states what the result of the combination of the three references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Uppaluru, Coffman, or Speicher themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify the Uppaluru/Coffman combination to include the teachings of Speicher. In other words, the Examiner *appears* merely to be stating that it would be obvious to modify the Uppaluru/Coffman combination to include the feature of the storage device comprising a relational database (as allegedly taught by Speicher), so that the Uppaluru/Coffman combination would be able to support a relational database. This is legally improper. For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 6 and 15 is improper and should be withdrawn.

C. Independent claim 23.

Independent claim 23 is patentable under 35 U.S.C. §103(a) over the combination of Uppaluru and Coffman, further in view of U.S. Patent No. 6,594,682 to Peterson *et al.* (“Peterson”).

Similar to independent claims 1 and 10, claim 23 recites the feature of initializing an outbound voice-enabled communication to a user. As such, the rejection of claim 23 is improper for *at least* the reason that the Examiner relies on the flawed Uppaluru/Coffman combination, as discussed in detail above with regard to the rejection of independent claims 1 and 10.

Claim 23 also recites the feature of “*enabling a user to subscribe to at least one voice service that can output information, wherein enabling a user to subscribe further comprises...enabling the user to specify a scheduling condition for executing the at least one voice service to generate the voice service output information.*” In the Final Action (at pg. 6), the Examiner concedes that the Uppaluru fails to teach this claim element. The Examiner relies on Peterson, however, for this teaching, alleging:

It would have been obvious to one skilled at the time the invention was made to modify Uppaluru to have “a call builder...documents” as taught by Coffman et al and “to specify a scheduling condition for executing the at least one voice service to generate the voice service output information” as taught by Peterson et al such that the modified system of Uppaluru would be able to support the outbound call and scheduling delivery to the system users.

Appellants disagree. The Examiner is further modifying the flawed Uppaluru/Coffman combination with Peterson without establishing a legally proper motivation for combining the three references. The Examiner’s recited motivation states

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what the result of the combination of the three references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Uppaluru, Coffman, or Peterson themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify the Uppaluru/Coffman combination to include the teachings of Peterson. In other words, the Examiner *appears* merely to be stating that it would be obvious to modify the Uppaluru/Coffman combination to include the feature of enabling the user to specify a scheduling condition for executing the at least one voice service (as allegedly taught by Peterson), so that the Uppaluru/Coffman combination would be able to support scheduling delivery to system users. This is legally improper.

Assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Uppaluru, Coffman, and Peterson, the three references, even if combined, fail to disclose, teach, or suggest all of the elements of claim 23. For example, claim 23 further recites the feature of storing a personalized markup language document for subsequent retrieval when an outbound voice-enabled communication to a user has not been successfully initialized. In the Final Action (at pg. 6), the Examiner alleges that Uppaluru teaches this claim element at col. 10, lines 19-49. Appellants note that nowhere in col. 10, lines 19-49 does Uppaluru appear to teach storing a personalized markup language document for subsequent retrieval when an outbound voice-enabled communication to a user has not been successfully initialized.

For *at least* the reasons set forth above, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claim 23 is improper and should be withdrawn.

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VIII. CLAIMS APPENDIX - 37 C.F.R. §41.37(c)(1)(viii)

The pending claims (claims 1-18, and 23) are attached in the Appendix.

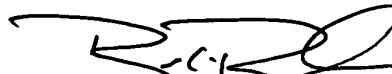
CONCLUSION

For at least the foregoing reasons, Appellants request that the rejection of claims 1-18, and 23 under 35 U.S.C. §103 be reversed.

Date: January 5, 2005

Respectfully submitted,

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CLAIMS APPENDIX

1. (*Previously Presented*) An integrated inbound and outbound voice service system comprising:

 a first system for generating markup documents personalized for subscribers of at least one voice service;

 a call server comprising:

 a storage device for storing the markup documents;

 a call builder operative to initiate an outbound voice-enabled communication to one or more subscribers using one or more of the markup documents; and,

 a call receiver operative to accept an inbound voice-enabled communication from one or more subscribers;

 wherein the call server accesses one or more of the markup documents for dynamically interacting with one or more subscribers of the at least one voice service during either outbound or inbound voice-enabled communications.

2. (*original*) The voice service system of claim 1 wherein the call server further comprises an authentication module operative to authenticate an inbound voice-enabled communication.

3. (*Previously Presented*) The voice service system of claim 1 wherein the call server further comprises:

a parser operative to extract text from the markup documents; and,
a text-to-speech engine for converting the extracted text into speech.

4. (*Previously Presented*) The system of claim 1 wherein the call server further comprises a search module operative to search markup documents stored in the storage device.

5. (*original*) The system of claim 4 wherein the search module comprises an SQL engine operative to query the storage device.

6. (*original*) The system of claim 1 wherein the storage device comprises a relational database.

7. (*Previously Presented*) The system of claim 1 wherein the markup documents comprise extensible markup language (XML) documents.

8. (*Previously Presented*) The system of claim 1 wherein the markup documents comprise active voice pages.

9. (*Previously Presented*) The system of claim 1 wherein the markup documents comprise information accessed from an on-line analytical processing system.

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10. (*Previously Presented*) A method for providing integrated inbound and outbound voice services comprising the steps of:

generating markup documents personalized for subscribers of at least one voice service;

storing the markup documents;

initializing outbound voice-enabled communications to one or more subscribers using one or more of the markup documents;

accepting inbound voice-enabled communications from one or more subscribers; and,

accessing one or more of the markup documents for dynamically interacting with one or more subscribers of the at least one voice service during either outbound or inbound voice-enabled communications.

11. (*original*) The method of claim 10 further comprising the step of authenticating inbound voice-enabled communications.

12. (*Previously Presented*) The method of claim 10 wherein the step of accessing for dynamic interaction comprises:

extracting text from the markup documents; and,

converting the extracted text into speech.

13. (*Previously Presented*) The method of claim 10 further comprising the step of searching the markup documents stored in the storage device for inbound voice-enabled communications.

14. (*Previously Presented*) The method of claim 13 wherein the step of searching comprises generating SQL statements to search for particular markup documents.
15. (*Previously Presented*) The method of claim 10 wherein the step of storing comprises storing markup documents in a relational database.
16. (*Previously Presented*) The method of claim 10 wherein the markup documents comprise extensible markup language (XML) documents.
17. (*Previously Presented*) The method of claim 10 wherein the markup documents comprise active voice pages.
18. (*Previously Presented*) The method of claim 10 wherein the markup documents comprise information accessed from an on-line processing system.

Claims 19-22. *cancelled*

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23. (*Previously Presented*) A method for providing integrated inbound and outbound voice services to one or more users, comprising:

enabling a user to subscribe to at least one voice service that can output information, wherein enabling a user to subscribe further comprises enabling the user to specify preferences for the content and presentation of the voice service output information, and enabling the user to specify a scheduling condition for executing the at least one voice service to generate the voice service output information;

initializing an outbound voice-enabled communication to the user when the scheduling condition has been satisfied;

dynamically interacting with the user, when the outbound voice-enabled communication has been successfully initialized, by presenting the user with personalized voice service output information from a personalized markup language document generated for the user; wherein the personalized markup document further comprises one or more embedded user prompts for enabling the user to respond to the personalized voice service output information received; and

storing the personalized markup language document, when the outbound voice-enabled communication to the user has not been successfully initialized, for subsequent retrieval and presentation to the user upon receiving an inbound voice-enabled communication from the user.